

In response to the Species Election Requirement, Applicants hereby provisionally elect, with traverse, species 2 for Category A, species 1 for Category B, and species 2 for Category C, as the elected species for examination on the merits.

It is respectfully submitted that at least claims 1-24 are readable on the elected species.

On page 3 of the Office Action, the Office indicated that Species I-III do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, the species lack the same corresponding technical on the basis that: (1) the species lack a common technical feature between them; (2) the species are mutually exclusive non-obvious variants of each other.

Applicants respectfully traverse this requirement.

First, it is respectfully submitted that the requirement is improper as a matter of law. The present application is a National Stage Application of PCT/FR03/03334. Pursuant to 37 C.F.R. § 1.499, unity of the invention practice must be followed for a National Stage Application, as described by 37 C.F.R. § 1.475. Accordingly, the Office is required to follow the rules regarding unity of invention in PCT rules 13.1 and 13.2. However, the Office appears to have improperly applied U.S. restriction practice for this application as evident by the rationale given for the restriction and the lack of a proper basis for a determination of lack of unity of invention. See,

*Caterpillar Tractor v. Commissioner of Patents and Trademarks*,  
650 F. Supp. 218 (E.D. Va 1986). See also M.P.E.P. § 1850.

Second, it is respectfully submitted that had unity of invention been applied, unity would have been found to exist and all of the claims would have been examined together in this application. In this regard, Applicants submit that the Office Action fails to satisfy its burden in showing that claims lack of unity under the requirements of PCT Rules 13.1 and 13.2.

Rule 13.1 does not contemplate an election of species as required by the Examiner and the existence of species for the generic claims does not form a basis for the alleged lack of unity of invention.

Further the allegation that the respective species are nonobvious variants is not an argument in support of the Examiner's position since PCT Rule 13.4 provides "it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention".

Determination of the lack of unity is possible only when the claims of different inventions lack a "special technical feature" relative to one another. In the present case, as independent claim 1 is a method for marking one face of an ophthalmic lens that is generic to the dependent claims, all of

the claims of Groups I-III, by definition, share the same special technical features of claim 1.

The Examiner's attention is respectfully directed to PCT Rule 13.2 in Part 1b of the Annex B of the administrative instructions under the PCT, which specifies that "special technical features" are those features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical feature". Thus, absent any showing that the claimed rail composition is present in a prior art reference, no determination of lack of unity can properly be made.

Therefore, as the Office Action fails to provide such a citation, Applicants believe that the species election requirement is improper as a matter of law.

Third, it is respectfully submitted that the species are sufficiently closely related that a search and examination of the entire application can be made without a serious burden to the Office.

Thus, in view of the above, it is believed that Applicants are entitled to an action on the merits of all pending claims, in their full scope, in the present application.

In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider and examine additional species, upon a determination of allowance of

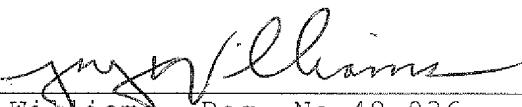
the generic claims, in accordance with U.S. election of species practice.

Favorable action on the merits is solicited.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

  
Jay Williams, Reg. No.48,036  
209 Madison Street, Suite 500  
Alexandria, VA 22314  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

JFW